

IAP7 Rec'd PCT/P 24 MAY 2006

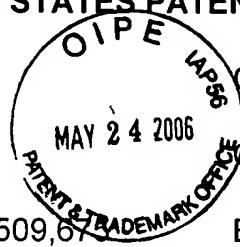
PCT
S#8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Del Soldato

Application Serial No.: 10/509,6



Confirmation No.: 3644

Group Art Unit: Unknown

Examiner: Unassigned

Filed: October 8, 2004

Attorney Docket No.: 026220-00055

For: Drugs for Arthritis Treatment

RECEIVED

RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 24, 2006

9 JUN 2006

Legal Staff
International Division

Sir:

This is in response to the Decision on Petition, dated April 14, 2006, regarding the applicants' Petition under 37 C.F.R. § 1.47(b), filed September 7, 2005, in response to the Notification of Missing Requirements dated March 9, 2005, which indicated that the oath/declaration of inventor Piero Del Soldato is missing.

The PCT Legal Examiner James Thompson acknowledged that, in their previous petition, the applicants satisfied the following requirements of 37 C.F.R. §1.47(b):

- (1) the requisite petition fee;
- (2) factual proof that the inventor cannot be reached after diligent effort or refuses to cooperate;
- (3) a statement of the last known address of the inventor; and
- (4) a showing that such action that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

PCT Legal Examiner James Thompson stated, however, that the applicants have not provided the following requirements: (5) an oath or declaration by the 37 C.F.R. § 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and (6) proof that the 37 C.F.R. § 1.47(b) applicant has sufficient proprietary interest in the application. Accordingly, applicants enclose the oath or declaration requested in requirement (5).

In order to further demonstrate proof of sufficient proprietary interest in the application of requirement (6) and to expedite prosecution of the present application, applicants also enclose the Declaration of Mr. Michele Garufi as Exhibit E. The assignee, Nicox S.A., through the undersigned, respectfully petitions the U.S. Patent and Trademark Office under 37 C.F.R. § 1.47(b) to consider following facts.

- 1) This invention is assigned to Nicox S.A., as evidenced by the assignment to Nicox S.A. from the inventor Del Soldato recorded at Reel No. 016272, Frame No. 0728. See the previously filed Exhibit A - Statement under 37 C.F.R. §3.73(b) by Dr. Giovanna Barchielli of Nicox S.A.
- 2) This invention was made by inventor Del Soldato while he was employed by Nicox S.A. See enclosed Exhibit E - Declaration of Mr. Michele Garufi and the previously filed Exhibit B - Statement by Ms. Patrizia Antognazza.
- 3) The inventor Del Soldato agreed in writing to assign the invention to the applicants. See the previously filed Exhibit A - Statement under 37 C.F.R. §3.73(b) by Dr. Giovanna Barchielli of Nicox S.A enclosing the "Non-Competition and Confidentiality Agreement" signed by Del Soldato on December 2, 1995.

4) The conditions of the employment contract were satisfied. See enclosed
Exhibit E - Declaration of Mr. Michele Garufi and the previously filed Exhibit B
- Statement by Ms. Patrizia Antognazza.

The applicants respectfully submit that presently filed Declaration of Mr. Michele Garufi (Exhibit E) and/or the previously filed Statement by Ms. Patrizia Antognazza (Exhibit B) are "statement[s] of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant" (MPEP 409.05(f)) and are sufficient to establish proprietary interest under 37 C.F.R. § 1.47(b).

For at least the above reasons, the applicants respectfully request that the Office of PCT Legal Administration grant this petition and forward the file to the Office of Initial Patent Examination (OIPE) for further processing. Any further delay will cause irreparable harm to the invention. If any questions or issues remain, the Office of PCT Legal Administration is respectfully requested to contact the undersigned to help with their resolution.

U.S. Patent Application Serial No.: 10/509,675
Inventor: Del Soldato
Attorney Docket No.: 026220-00055

As this response is filed within two months of the Decision on Petition, the applicants do not believe that a fee is due. If this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The Commissioner is authorized to charge any additional fees or credit any over-payments to Deposit Account No. 01-2300, referencing Attorney Docket No. **026220-00055**.

Respectfully submitted,

ARENT FOX PLLC



Amy E.L. Schoenhard
Registration No.: 46,512

Customer No.: **004372**
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Telephone No.: 202-857-6000
Facsimile No.: 202-857-6395

Enclosures: Oath or declaration by the 37 C.F.R. § 1.47(b) applicant
Exhibit E - Declaration of Mr. Michele Garufi

Application Serial NO. 10/509,675
Petition under 37 C.F.R. § 1.47(b)

Exhibit E



HFZSP6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 3644

Del Soldato

Group Art Unit: Unknown

Application Serial No.: 10/509,675

Examiner: Unassigned

Filed: October 8, 2004

Attorney Docket No.: 026220-00055

For: Drugs for Arthritis Treatment

Declaration of Mr. Michele Garufi

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, Michele Garufi, hereby declare and state:

1. I am the Chief Executive Officer (CEO) of Nicox S.A. ("Nicox"). I have been CEO of Nicox from 1996 to the present.
2. Dr. Piero Del Soldato was employed by Nicox from December 1, 1999 to April 2, 2004.
3. During his time at Nicox, Dr. Del Soldato was the sole inventor for the subject matter that comprises Italian Patent Application No. MI 2002A/000773 filed in the Italian Patent Office on April 11, 2002.
4. On March 27, 2003, Nicox filed a PCT application (assigned PCT Application No. PCT/EP03/0318311/084,189 and published as WO03/084550) based on this Italian application. Dr. Del Soldato was the sole inventor for the subject matter that comprises the PCT application.
5. On October 8, 2004, Nicox filed a U.S. patent application (assigned U.S. Patent Application No. 10/509,675) based on the PCT application. Dr. Del

Soldato was the sole inventor for the subject matter that comprises the U.S. application.

6. I am familiar with these patent applications and the employment contract with Nicox signed by Dr. Del Soldato on December 2, 1995.

7. The employment contract refers to Dr. Del Soldato as "Manager", as defined in section 1.

8. "Nicox Group" is defined section 1.1 in the employment contract to mean "NICOX and its subsidiaries, . . ."

9. Section 3.1 of the employment contract indicates that "[s]o long as the Manager is . . . employed in any way by, the Nicox Group . . . The Manager expressly acknowledges and accepts that any intellectual and/or industrial property rights, in particular patent rights, of any kind or nature, which may be created or developed by him in the field of ethical or over the counter pharmaceutical or parapharmaceutical products which include an NO donor group, shall be the sole property of the Nicox Group. The Manager hereby renounces and forgoes to any and all intellectual and/or industrial property rights to which he may have rights to as a result of his co-operation with the Nicox Group."

10. The subject matter of Italian Patent Application No. MI 2002A/000773 and the above-related PCT and U.S. patent applications are within the scope of the employment contract and all conditions of the employment contract have been met to require assignment of these applications to Nicox.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and/or imprisonment under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Name: 

Date: May 12th, 2006